UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/086,244	03/01/2002	John S. Brown	P-25,673 USA	7792

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(SAUL-RSW) PATENT DOCKETING CLERK
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EXAMINER
DANNEMAN, PAUL

ART UNIT	PAPER NUMBER
3627	

MAIL DATE	DELIVERY MODE
11/26/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

PTOL-90A (Rev. 04/07)

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>02 June 2008</u>.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-21</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-21</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____ .

DETAILED ACTION

The "Final Rejection" mailed 8/22/2008 has been completely vacated in favor of the below non-final Office action.

In view of the Appeal Brief filed on 6/2/08, PROSECUTION IS HEREBY REOPENED. An action is set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:

/F. Ryan Zeender/

Supervisory Patent Examiner, Art Unit 3627

Claim Rejections - 35 USC § 103

1.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2.   **Claims 1-21** are rejected under 35 U.S.C. 103(a) as being unpatentable over Arora et al. (2003/0195780 A1) in view of Lewis (6,513,019 B2) and Hynes (2003/0046176 A1).

Arora et al. shows all of the limitations of the claims except for specifically disclosing a method "for specifying an error notification" and does not specifically disclose the "detecting when a capitalized fixed asset is involved in a transaction" per se.

Arora et al. shows a computer-based optimization system for financial performance management.

Step 1 – Paragraphs [0015-0018] show various methods tracking, optimizing and projecting tax liabilities for business entities. Paragraph [0016] specifically shows a method for projecting tax liability when business entity structures are combined, split or transferred (transactions). Paragraph [0017] shows inter-company transactions and optimizing the transfer prices of goods and services to meet business purposes such as tax liability or cash flow.

Step 2 - Paragraph [0051] shows providing data elements, which describe things like legal entities, tax rules and jurisdictions that are to be modeled. (The system requires certain data, which qualifies as queries.) Paragraph [0048] shows a regulatory database 248 containing jurisdiction tax laws. (Each tax law has criteria as to what is taxable. The jurisdiction is the location of the asset and the category is the type of taxable asset.)

See paragraphs [02 and 07] of provisional.

Step 3 – If a fixed asset described above has an applicable tax law, it meets the criteria. The applicable tax calculation (audit) is performed for each applicable location. See the example in paragraph [0004], which weighs allocations in Nevada versus California. (This is running data to determine a location.) See paragraph [03] of provisional.

Step 4 – The decision of the business entity doing the "what if/optimization" process will assign a location on their tax forms. (In whichever jurisdiction they filed in.)

See paragraph [03] of provisional.

The reference is not completely silent about error notification. See Paragraphs [0065, 0066, 0055 and 0056] and Fig.4 and Fig.6 (error message at top of the web page regarding errors in the calculated values.) Furthermore, in paragraphs [0060, 0061 and 0062] the user is notified that certain items are "dirty" and need recalculation. See paragraph [0078] regarding adding legal entities to more then one group. The system is checking for illegal entries.

As for hierarchically order, this is incorporated in tax laws. For example, Nevada does not have state tax. There would be no data required (queries) for state taxes once

Nevada was entered. Paragraph [0085] teaches the use of a wizard "stepping through a process" for handling complex tax planning activities such as combining or splitting entities, moving factors between entities or states, or optimizing transfer pricing based on existing inter-company transactions. Also, see paragraphs [0088 through 0092] where two legal entities are being combined the process for combining the legal entities (transaction of an asset) is hierarchical in nature.

Lewis teaches a financial consolidation and communication platform. In column 17, lines 23-33, the validation process teaches creating an error message in response to missing data and sending notifications to the appropriate staff, who can then correct the data.

Based on the teaching of Lewis, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to modify the Arora et al. system to incorporate an error notification when data was missing or not matching in order that the situation can be addressed by the appropriate operator.

Hynes teaches a one page purchasing system. The system is conducted by software on a network. The purchase is considered to be the detected transaction. Paragraph [0001] anticipates that purchases can be capitalized as fixed assets. Detecting transactions provides accounting with input to facilitate optimization processes.

Based on the teaching of Hynes, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to modify the Arora et al. system to incorporate the computerized purchase method of Hynes to provide detection of

capitalized fixed asset to be provided as input to the Arora et al. system in order to

provide accounting with input to facilitate optimization processes.

Response to Arguments

3.   Applicant's arguments with respect to all claims have been considered but are

moot in view of the new ground(s) of rejection.

Conclusion

4.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to PAUL DANNEMAN whose telephone number is

(571)270-1863. The examiner can normally be reached on Mon.-Thurs. 6AM-5PM Fri.

off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Florian Zeender can be reached on 571-272-6790. The fax phone number

for the organization where this application or proceeding is assigned is 571-273-8300.

5.   Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Paul Danneman/

Examiner, Art Unit 3627

15 November 2008

/F. Ryan Zeender/
Supervisory Patent Examiner, Art Unit 3627